

REMARKS

This letter is responsive to the office action mailed January 23, 2009.

Claims 5, 6, 27 and 28 are cancelled, without prejudice.

Claims 1 and 45 are amended, based on limitations previously recited in claims 5 and 6. Claim 23 is amended, based on limitations previously recited in claims 27 and 28. The independent claims are also amended to recite subject matter disclosed in paragraphs [0020] and [0025] of the specification. Additional amendments have been made to enhance clarity. No new matter has been added to the claims.

Accordingly, **claims 1, 7-14, 23, 29-36, 45 and 46** remain pending in the application. Claims 1, 23 and 45 are independent.

Claim rejections under 35 U.S.C. §112

Claims 1, 23 and 45 were rejected as being indefinite for failing to particularly and distinctly claim the subject matter regarded as comprising the invention, these claims in particular including the phrase "a particular one." Claims 6 and 28 were also rejected as reciting the limitation "the proxy" without having a clear antecedent basis.

In order to expedite prosecution of the application, claims 1, 23 and 45 have been amended to provide greater clarity. Claims 6 and 28 have been canceled.

Claim rejections under 35 U.S.C. §103

Claims 1, 5-14, 23, 27-36, 45 and 46 were rejected under 35 U.S.C. 103(a) as being obvious in view of U.S. Patent No. 7,216,072 issued to Kasai et al. (hereinafter "Kasai"). Applicants respectfully traverse all rejections.

By way of background, and according to the subject matter of the amended claims, a mobile computer device sends an initial message containing text to a proxy, which then converts the initial message into a new format that is compatible with a processing server. The new format specifically is Hypertext Markup Language (HTML). Once converted into HTML format, the initial message is sent by the proxy to the processing server to be processed into a processed message. Upon receiving the processed message back from the processing server, the proxy then converts the processed message into a device-formatted representation of the processed message, before sending it to the mobile computer device.

The skilled person would clearly understand that the Applicants' claimed proxy and processing server perform certain specific and useful functions. The proxy converts messages received from the mobile computer device into HTML format to make those messages compatible with the processing server; and it converts processed messages received back from the processing server into device-formatted representations to make them compatible with the mobile computer device again. The proxy converts the format of a message but not its content. Message content is processed in the processing server (by way of e.g. translation, spell/grammar check, encryption) into new or modified content. However, the processing server operates on messages of a particular format that is not necessarily the same format in which the messages are initially sent by the mobile computer device. The proxy is included to convert otherwise incompatible messages transmitted back and forth between the mobile computer device and the processing server into compatible formats. Accordingly, the mobile computer device and the processing server can appear to one another as compatible devices when otherwise, in absence of the proxy, they would not have been.

Kasai fails to teach that the “new format compatible with the processing server” is HTML

First, Kasai fails to teach that the “new format compatible with the processing server” is HTML, as required by the independent claims. The Examiner concedes this at page 5 of the office action.

In the event that the cited references fail to disclose or suggest all of the elements recited in the claims, then combining elements from the references would not yield the claimed subject matter, regardless of the extent of any teaching, suggestion or motivation. This is strong evidence of non-obviousness.

It would not be obvious to a person of ordinary skill in the art to modify the teachings of Kasai to arrive at the Applicants’ claimed embodiments

The Examiner suggests on page 5 of the office action that it would be obvious to modify Kasai to use HTML in the translation of e-mails. It is worth noting that the Examiner based many of the obviousness references upon a single reference, namely Kasai. In those instances in which an Examiner relies upon a **single** reference, the Examiner is reminded that there must be evidence of a teaching, suggestion or motivation to modify that reference: *In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). It is respectfully submitted that the Examiner has yet to provide such evidence to comply with this rule.

The Examiner is also respectfully reminded that the evidence on the record must suggest the *desirability* of the change or combination, not merely the feasibility: See *In re Fulton*, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004). The Applicants submit that the prior art does not suggest that it would be desirable to modify Kasai to employ a processing server that requires input to be in HTML for compatibility, and in fact, Kasai teaches away from such a processing server, as will be explained below.

The Teachings of Kasai

In a first embodiment, Kasai describes a method and system for translating web pages accessed on a client device. For this purpose, Kasai describes a client device, a translated text cache server, and a translation server: see e.g. Figure 1. In response to the client device requesting a particular web page, the translated text cache server relays the request to a WWW server, whereupon the WWW server sends the web page to the translated text cache server as HTML data. The translated text cache server removes a tag from the HTML data and extracts text information. The text information is sent to the translation server for translation into a different language, and then sent back to the translated text cache server for embedding into the original HTML data. The HTML data containing the translated text information is then transmitted to the client device as a translated web page: see e.g. col. 6, lines 15-57.

In second, third, and fourth embodiments, Kasai describes a method and system for translating emails. For this purpose, Kasai describes a mail server, a client device, a translated mail server and a translation server: see e.g. Figure 9. Incoming emails to a mail server are monitored and judged by the translated mail server to require translation, whereupon the **text information** to be translated is extracted from the email message and sent to the translation server. Once translated, the text information is sent back to the translated mail server for incorporation into the email. Text information can be extracted either from the body of the email or else from an appended document: see e.g. col.15, line 8 to col. 16, line 21.

The second, third and forth embodiments appear to describe variations of the same underlying functionality. The second embodiment appears to be characterized in that the translated mail server judges that translation is required by recognizing characteristic word strings in the email (see e.g. Fig. 13), while the third embodiment appears to be characterized in that the judgment is based on the identities of the sender and receiver of the email (see e.g. Fig. 15). The

fourth embodiment appears to be characterized in that the email actually originates from the client device and is appended with a document that was being used on the client device and that requires translation (see e.g. Fig. 17).

The translation server and the translated mail/text cache server in these embodiments of Kasai all appear to share certain features. For example, the **translation server appears only to receive text information** from the translated mail/text cache server, translate the text information into a different language, and then send the translated text information back to the translated mail/text cache server. For its part, the translated mail/text cache server receives an incoming message in some initial format and, from that message, extracts and sends text information to the translation server for translation. The translated mail/text cache server will subsequently receive translated text information from the translation server and embed it into the original received message to be sent to the client device.

At page 4 of the office action, the Examiner maintains that the **translated mail server (32)** and the translation server (33) in Kasai are, respectively, equivalent to the proxy and the processing server in the claims. That is, according to the Examiner, the translated mail server 32 in Kasai teaches converting a message into a new format before sending the message to the translation server. The Examiner states that Kasai does not specifically mention conversion into HTML format, but that it would have been obvious to do so because one of ordinary skill in the art would know that emails can be sent in several formats, including HTML, and would therefore certainly consider this language.

However, at page 5 of the office action, the Examiner also maintains that Kasai discloses the proxy converting the processed message into a device-formatted representation of the processed message. The fact that the **WWW servers** described by Kasai use HTML, according to the Examiner, implies that the proxy converts the message into a device-formatted representation.

First, it appears that the Examiner has attributed two different servers disclosed in Kasai, in respect of two different embodiments, as representing the claimed proxy. It is respectfully submitted that that this inconsistency would suggest that Kasai fails to disclose a server that provides all of the formatting functions of the Applicants' proxy as recited in the amended claims.

Second, while the translated mail server 32 may appear to function as a proxy for the translation server 33, it still does not appear to be exactly equivalent to the claimed proxy. A distinction can be drawn between the format and content of messages transmitted on computer networks. The ordinary skilled person would understand that the content of a message generally relates to the semantic meaning of any included text information, while the format of a message generally relates to the communication protocol chosen for transmission of the message, so that the included text information can be properly interpreted by other devices on the computer network for example.

The translated mail server in Kasai only extracts the included text information for processing without converting the format of the original message. After translation, text information is returned to the translated mail/text cache server for reincorporation into the original message without conversion of the message's format. Extraction of text information can, on this basis, usefully be distinguished from conversion of message format. The latter is recited in the Applicants' claims, but is not taught by Kasai.

Furthermore, the Applicants' claimed proxy is clearly distinguishable from Kasai's translated mail server in that messages received from the mobile computer device by the Applicants' proxy are converted into a format that is compatible with the processing server, and processed messages received back from the processing server are converted into a device-formatted representation for transmission to the mobile communication device. In other words, the Applicants' proxy does not just extract text information for processing in the processing server. The proxy converts the format of a message, sent according to one

communication protocol by the mobile device, into a new format to be compatible with a different network device, i.e. the processing server, which operates using a different communication protocol. This **format conversion** is not present in Kasai.

The Examiner's position appears to be that, in Kasai's fourth embodiment, the client device may send an e-mail containing an appended document to the translated mail server, and that the ordinarily skilled person would find it obvious that the format could be converted into HTML by the translated mail server for transmission to the translation server. However, in Kasai's first embodiment, the web pages received by the translated text cache server are already in HTML format and, instead of transmitting the web page straight to the translation server, the translated text cache server "removes a tag (corresponding to display control information) of the HTML data, and reads text information. The translated text cache server 2 transmits this item of text information to the translation server 3 on the network" (col. 6, lines 34).

Therefore, if the translation server 3 could accept messages in HTML format, why would there be a need for the translated text cache server 2 to remove the tag and extract text information? There is no suggestion in Kasai that the translation server 33 in Kasai's fourth embodiment functions differently from the translation server 3 of Kasai's first embodiment. Further, if indeed e-mails can be sent in HTML format in Kasai as the Examiner suggests, but the translation server 33 requires input also in HTML format, then why would a translation mail server 32 be required at all for any format conversion? It is respectfully submitted that Kasai effectively **teaches away** from employing a translation server being a processing server that requires input to be in HTML format. For greater certainty, this feature is recited in the amended claims. The Applicants' proxy is used in a specific context, and the claims are not intended to pre-empt all uses of proxy and processing servers.

Finally, the Applicants recognized that there are certain advantages to the inclusion of the claimed proxy between the mobile computer device and the processing server. As the amended claims now clarify, the computer network on which the proxy and the processing server are installed may be the Internet, in which case the processing server may be a public domain server. One advantage to be had by including the proxy is that it makes it possible for the mobile computer device to access and use the public domain server so that messages sent from the mobile computer device can be processed. Making it possible for the mobile computer device to use services provided by publicly accessible processing servers eliminates the need for equivalent services to be installed directly on the mobile computer device. As a result, processing resources and battery life on the mobile computer device may be conserved.

In view of the foregoing, it is clear that Kasai fails to disclose all the limitations of the claims, and that Kasai teaches away from the modification suggested by the Examiner. Applicants respectfully submit that **claims 1, 7-14, 23, 29-36, 45, and 46**, as amended, are patentable over Kasai and the other references relied upon by the Examiner. Withdrawal of the remaining objections under 35 U.S.C. 103 is respectfully requested.

Final Remarks

The Applicants note that the Supreme Court's *KSR* decision¹ did not reject the use of a "teaching, suggestion or motivation" analysis as part of an obviousness analysis. The Supreme Court characterized the analysis as a helpful insight. It is respectfully submitted that the absence of a teaching, suggestion or motivation is a significant point in the Applicants' favor, as this absence is indicative of non-obviousness.

Although the Supreme Court did not reject use of a "teaching, suggestion or motivation" analysis, the Supreme Court did say that it was not the only possible

¹ *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007).

analysis of an obviousness question. In the event that the Examiner chooses to pursue a different avenue for rejection, the Examiner is invited to explicitly identify the rationale and articulate the reasons on which such rejection is based, and it should be noted that any new avenue would be a new ground for rejection not due to any action by the Applicants.

The Applicants further respectfully remind the Examiner that, even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning; (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness; (4) hindsight has no place in an obviousness analysis; and (5) Applicants are entitled to a careful, thorough, professional examination of the claims (in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

In view of the foregoing, Applicants submit that each of **claims 1, 7-14, 23, 29-36, 45, and 46** are now in condition for allowance, and a notice to that effect is respectfully requested.

Yours truly,

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